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10/057,522	01/24/2002	Federico Granzotto	BA-22808	4324

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/22/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/057,522

Applicant(s)

GRANZOTTO, FEDERICO

Examin r

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears n the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-5 are pending.

#### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Italy on 1/24/01. It is noted, however, that applicant has not filed a certified copy of the Italian application as required by 35 U.S.C. 119(b).

#### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Specifically, part of the date on which the inventor signed, has been whited out.

#### ***Specification***

(i) The disclosure is objected to because of the following informalities: Page 2, last full paragraph, recites "99,9%" in reference to water. This objection can be overcome by replacing the comma with a period.

Appropriate correction is required.

(ii) The abstract of the disclosure is objected to because it is confusing. The Examiner respectfully requests that Applicant amend the Abstract so that its content is in proper English. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 1 is vague and indefinite, as it is confusing.

1. What does it mean that a composition is fit to be applied to the skin? The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

2. The term "complete" in line 3 is a relative term. What does it mean to obtain a complete anti-wrinkle effect. The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

3. The phrase "so as" is confusing. Does it mean that the product stretches skin and makes it smoother or does "so as" mean something else?

4. The phrase "characterized by" in line 4 is vague and indefinite. Does the product actually comprise a composition of silica and water or does the product resemble a composition of silica and water.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the

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explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "skin", and the claim also recites "particularly on face skin" which is the narrower statement of the range/limitation.

6. The term "preferably" in lines 7 and 10 are vague and indefinite, as the metes and bounds of the claim are unascertainable. Is "ambient temperature" a limitation or is Applicant merely stating that the combining can be done at ambient temperature?

(ii) Claim 2 is vague and indefinite, as it is confusing.

1. The phrase "characterized by" in line 2 is vague and indefinite. Does the product actually comprise a composition of silica and water or does the product resemble a composition of silica and water. Does the product actually have the recited percent weights or does the product resemble a composition with the recited percent weights?

2. The term "preferably" in line 3 is vague and indefinite, as the metes and bounds of the claim are unascertainable. Are the percent weights recited in the claims a limitation or is Applicant merely stating that the two ingredients can have the recited percent weights?

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3. What does it mean that the first and second component "may be used" in the recited solutions and systems? Does it mean that they can be in the form of the recited solutions and systems? What does "may be used" mean?

4. What are sol systems, gel systems, and aerosol systems? Are they devices? Are they solutions? The specification does not define these terms and one of ordinary skill in the art would not be apprised of their meaning.

(iii) Claim 3 is vague and indefinite, as it is confusing.

1. The phrase "characterized by" in line 2 is vague and indefinite. Does the product actually comprise excipients or does the product resemble a product comprising excipients?

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation excipients, and the claim also recites "such as for example moisturizing agents, soothing agents. . .film making agents and the like", which is the narrower statement of the range/limitation.

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3. The phrase “and the like” on the last line, renders the claim indefinite because the claimed product includes elements not actually disclosed (those encompassed by “and the like”) and the scope of the claim is unascertainable.

4. The phrase “said excipients are the same normally used in cosmetic products” is vague and indefinite. What are excipients normally used in cosmetic products? Is Applicant saying that excipients commonly used in nail varnishes are also commonly used in skin masks or moisturizing products? What delineates excipients as “normally” used?

(v) Claim 5 is vague and indefinite, as it is confusing.

1. The phrase “characterized by the use” in line 2 is vague and indefinite. Does the product actually comprise a composition of silica and water or does the product resemble a composition of silica and water. Since the intended use of a product claim is not given patentable weight, claim 5 recites no positive elements, as the product is merely being described by a way in which two components in a composition can be utilized. Thus, it is not clear what this claim is actually reciting as its product constituents.

2. The phrase “possible excipients of the types commonly used in cosmetic industry” is vague and indefinite, as it is confusing. What compounds are encompassed by this phrase? The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Holcomb (5,658,573).

Holcomb exemplifies a composition comprising 58.39% water, 0.83% of an aqueous suspension of colloidal silica, 8.44% mineral oil (excipient), 4% glycerine (excipient). See Col. 7, lines 29-54.

It is respectfully pointed out that the above composition is a sol, as a sol is defined as a colloid solution consisting of a suitable dispersion medium.

The Examiner respectfully points out instant claim 1 is a product-by-process claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

It is respectfully pointed out that, the recitation “Anti-wrinkle product, fit to be applied on skin and particularly on face skin, for obtaining an excellent and complete anti-wrinkle effect, so as to stretch skin and make it smoother”, has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process



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steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holcomb as applied to claims 1-2 and 4-5 above.

Holcomb is applied as discussed above. The reference lacks preferred percent weight of water.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Holcomb to exemplify water as comprising 97% of the composition because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233) and because of the expectation of achieving a product that flows and that can be applied over a large surface area.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
June 26, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

6/26/03